

REMARKS**I. Petition Under 37 C.F.R. § 1.136(a)**

Pursuant to 37 C.F.R. § 1.136(a), applicant hereby petitions for a three-month extension of the shortened statutory period set for reply to the Final Office Action dated December 23, 2008. A credit card authorization form in the amount of \$555.00 in payment of the fee set forth in 37 C.F.R. § 1.17(a)(3) is transmitted herewith.

II. Notice of Appeal Pursuant to 37 C.F.R. § 41

Pursuant to 37 C.F.R. § 41, applicant files herewith a Notice of Appeal pursuant to 37 C.F.R. § 41. A credit card authorization form in the amount of \$270.00 in payment of the fee set forth in 37 C.F.R. § 41.20(b)(1) is transmitted herewith.

III. Introduction

Claims 1-56 are canceled without prejudice.

Claims 57-102 are pending in the case.

Applicant notes with appreciation that claims 84-88, 91-95 and 97-101 are indicated as allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims.

Claims 57, 66 and 75 are rejected pursuant to 35 U.S.C § 112 as allegedly failing to comply with the written description requirement.

Claims 57, 62-66, 71-74, 75, 80-83 and 90 are rejected under 35 U.S.C § 102(e) as being anticipated by U.S. Patent 6,845,398 to Galensky et al. ("Galensky").

Claims 58-61, 67-70, and 76-79 are rejected under 35 U.S.C § 103(a) as being unpatentable over Galensky in view of U.S. Patent 7,088,990 to Isomursu et al. ("Isomursu").

III. Applicant's Reply to the Rejection under 35 U.S.C § 112

Claims 57, 66 and 75 are rejected as allegedly failing to comply with the written description requirement. Applicant respectfully traverses this rejection based the remarks below.

One aspect of applicant's claimed invention is concerned with systems and methods that allow a user to customize his or her wireless telephone by programming a selected video file into the wireless telephone for subsequent use as an indicia of an incoming communication. Generally speaking, this may be thought of as a way for users to customize their wireless telephone by selecting and programming a certain video segment (such as a video clip or portion thereof) into their wireless telephone, for use as a

ringtone, which plays when an incoming telephone call (or other communication) is received.

One benefit of the of the claimed invention is that it provides the user of the wireless telephone with the freedom and flexibility to select (and/or change to) a particular video file for use as indicia of an incoming communication that is pleasing to the user rather than be constrained to a conventional audio-only ringtone (or small group of audio-only ringtones) which may have been pre-programmed by, or available from, the handset manufacturer (as is described in Isomursu).

Applicant's specification recognizes that prior art systems were very limited in this regard and did not provide any such features, and that one reason such customization is desirable is because it is confusing when a telephone of a nearby user generates a sound (e.g., such as a ringtone) similar to or the same as that of the user's device. See published application US 2004/0005880 A1 (the '880 application) at paragraph 4.

Applicant's claimed invention provides systems and methods that address these and other shortcomings in the prior art. For example, independent claim 57 specifies a system for providing a video file to a wireless telephone for use as an indicia of an incoming communication. Ample written description for each of the elements recited in this claim (and claims 66, and 75) may

be found in applicant's specification. For example, support for the first claim element "a remote computer with access to a database of video files suitable for downloading to the wireless telephone wherein the remote computer is configured to" may be found in the '880 application in at least paragraphs 8, 24-25, 39, 41-42, the Summary, and the associated figures.

Support for the second claim element "provide a list of video files in the database to a user of the wireless telephone when the user requests the list of video files" may be found in the '880 application in at least paragraphs 41-42 and the associated figures.

Support for the third claim element "allow the user of the wireless telephone to browse the list of video files" may be found in the '880 application in at least paragraphs 41-42, paragraph 61, and the associated figures.

Support for the fourth claim element "allow the user of the wireless telephone to select a desired video file from the list of video files" may be found in the '880 application in at least paragraphs 39, 41-42 and 61 and the associated figures.

Support for the fifth claim element, "allow the user of the wireless telephone to optionally download a selected video file into the wireless telephone for future use as an indicia of the incoming communication" may be found in the '880 application in

at least paragraphs 25, 41-42, 45 and the associated figures.

More specifically, paragraph 25 teaches that:

In operation, a user may choose certain information, such as... a video clip or frame, etc., that is available from source 50... and program it into a programmable memory within device 20. Device 20 may then retrieve this information when a certain event occurs (e.g., **when receiving an incoming telephone call...** (emphasis added))

Paragraph 45 further explains that:

In another embodiment, a user may program certain audio or video files into device 20 that **are activated when a certain person calls.** (emphasis added)

Thus, it can be seen from the two excerpts above that applicant's specification clearly teaches that a video file may be downloaded into a wireless telephone and used as an indicia of the incoming communication. This support is virtually word for word and would be easily understood by one of ordinary skill in the art. Further support for this feature may also be found in FIGS. 1-12 and its associated description, but is deemed unnecessary in view of the strong support provided above.

In addition, applicant's specification explains that the video files described above may be obtained from a remote computer or Internet site having extensive collections of such materials for downloading to telephones. See, Paragraphs 39 and 41 for example.

This allows a user to select information, such as audio and/or video, that is available on the Internet or on a remote network computer, and program that information into device 20.

In some embodiments of the present invention, computer 90 may simply contact a remote computer or Internet site to fulfill requests **for audio or video information** in a particular format. Such web sites or remote computers may act as virtual "jukeboxes" **of video and audio information**, containing extensive lists of such information in a variety of formats **available for downloading**. (emphasis added)

Moreover, the specification teaches confirming the selected video file has been properly received by the wireless telephone. Support for this feature can be found at least at Paragraph 39 of the '880 application (last two sentences) and the associated figures.

Accordingly, based on the above, applicant respectfully submits that that independent claims 57, 66, and 75 are fully supported by written description and requests that the rejection pursuant to 35 U.S.C. § 112 be withdrawn.

IV. Applicant's Reply to the Rejection Under 35 U.S.C. § 102(e)

Claims 57, 62-66, 71-74, 75, 80-83 and 90 are rejected under 35 U.S.C § 102(e) as being anticipated by U.S. Patent

6,845,398 to Galensky et al. ("Galensky"). Applicant respectfully traverses.¹

As mentioned above, one aspect of applicant's claimed invention is concerned with systems and methods that allow a user to customize his or her wireless telephone by programming a selected video file into the wireless telephone for subsequent use as an indicia of an incoming communication. Generally speaking, this may be thought of as a way for users to customize their wireless telephone by selecting and programming a certain video segment (such as a video clip or portion thereof) into their wireless telephone, for use as a ringtone, which plays when an incoming telephone call (or other communication) is received.

Independent Claims 57, 66 and 75

Galensky, on the other hand, does not show or suggest these features anywhere. For example, Galensky is purportedly concerned with a means for streaming multimedia content from a server to a playback device (see Abstract). Galensky explains that a user may select certain multimedia content, which is streamed to the user's device upon request, for immediate playback (i.e. "real time" playback). This streamed content is not stored on the playback device. Galensky explains that the multimedia content is only

¹ It is believed the rejections based on Galensky and Isomursu are rendered moot based on applicant's reply to the rejection under 35 U.S.C. § 112 herein and in view of the reasons given for allowability over these references in applicant's reply dated August 29, 2008. Nevertheless, applicant includes these reasons here for the convenience of the Examiner.

played once (i.e., as the content stream is received) and thus is not stored on the playback device for future use as specified in applicant's claims (see Galensky, column 5, lines 31-42 and column 6, lines 45-57). Thus, it is clear that such streamed content cannot be used as indicia of an incoming communication.

Further, applicant points out that the system of Galensky interacts with a very simple flash memory-type playback device such as a first generation MP3 player, which merely provides one basic function, namely the playback of streamed multimedia content and is not a wireless telephone. Therefore, it cannot receive incoming telephone calls, and consequently has no need for ringtone, video or otherwise (see, e.g., Galensky column 3, line 64 to column 4, line 47 and FIG. 2 and its associated description). Accordingly, the streaming-based system of Galensky does not show or suggest providing a video file for future use as indicia of an incoming communication as specified in applicant's pending claims.

Galensky does mention that under certain circumstances a multimedia file may be stored on the playback device. In this case, however, Galensky requires that the playback device must contact the multimedia server and complete a payment transaction in order to obtain a new authorization code each time the user wants to play the stored content again (see Galensky, column 7,

lines 30-41). Because of this cumbersome restriction, the system of Galensky cannot provide a video file for future use as an indicia of an incoming communication (e.g., because even if the playback device of Galensky could receive incoming telephone calls (which it cannot) they would be missed before a new content authorization code could be obtained allowing content playback; and, furthermore, competition among playback device applications for control of the single communications link to achieve competing goals (receive call or get authorization code) would cause further irreconcilable problems, preventing any authorization code from being obtained in a timely manner).

Moreover, applicant further points out that the system of Galensky merely provides multimedia content for "on-demand" consumption by the user (e.g., see Galensky, column 5, lines 36-46 and column 6, lines 53-57). Because the user receives or has access to content shortly after it is requested, there is no need (or purpose) for an indicia of an incoming communication (such as a video ringtone), because the user receives the information in response to his or her request and thus knows when to expect to receive (or have access to) the requested information (as opposed to a communication initiated by another, which cannot be predicted by a user, requiring that the user be alerted with an indicia of the incoming communication, such as a video ringtone). As a

result, the streaming based, on-demand playback system of Galensky teaches away from the features of applicant's claimed invention.

Accordingly, based on the above, applicant respectfully submits that independent claims 57, 66 and 75, and the claims that depend therefrom, are allowable over Galensky and requests that the rejection pursuant to 35 U.S.C. § 102(e) be withdrawn.

Further Distinctions Over Galensky

In addition, the Examiner further contends that Galensky teaches preventing the unauthorized distribution of a downloaded video file and confirms successful receipt of the video file, respectively. Applicant respectfully disagrees. Galensky does not store the downloaded video file on the playback device (and does not discuss distribution restrictions). See Galensky, col. 6, lines 53-56. Thus, claims 64, 73 and 82 are allowable over Galensky for at least this further reason.

Moreover, streaming systems, such as the one described in Galensky are incapable of confirming proper receipt of a communication. Column 2, lines 14-28 of Galensky have nothing to do with confirming proper receipt of a communication, but rather merely discuss the quality of an MP3 file. Thus, claim 90 is allowable over Galensky for at least this further reason.

Moreover, the streaming Galensky's does not provide any information regarding the memory capacity of the playback device

(which is not a telephone, but merely a rudimentary MP3 player). Nowhere is this feature shown or suggested in Galensky (and no cite to this feature is provided). The streaming based system of Galensky does not coordinate content download based on memory capacity. Such streaming-based systems merely stream data to a user substantially regardless of playback device memory capacity and without user notification. Accordingly, applicant respectfully submits the features specified in these claims are indeed novel in the wireless content distribution context as claimed. Accordingly, claims 65, 74 and 83 are allowable over Galensky for at least this further reason.

In addition, Galensky does not show providing a plurality of lists of video files for browsing by the user of the wireless telephone. As explained above, Galensky does not disclose a telephone but rather a rudimentary single function MP3 player. Accordingly, claims 62, 71 and 80 is allowable over Galensky for at least this further reason.

Accordingly, based on these further reasons, applicant respectfully submits that independent claims 57, 66 and 75, and the claims that depend therefrom, are allowable over Galensky and requests that the rejection pursuant to 35 U.S.C. § 102(e) be withdrawn.

IV. Applicant's Reply to the Rejection Under 35 U.S.C. § 103(a)

Claims 58-61, 67-70 and 76-79 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Galensky in view of Isomursu. Applicant respectfully traverses this rejection in view of the remarks below.

Independent claims 57, 66 and 75, have been established above as being allowable over Galensky. Therefore, these claims, and the claims that depend therefrom, are also allowable over the Examiner's proposed combination of Galensky and Isomursu for at least the same reasons.

However, the rejected claims are further allowable over the proposed combination for at least the following further reasons. Claims 58, 67 and 77 specify allowing the user of the wireless telephone to search the database of video files for a certain video file using title or description information. The feature is not shown or suggested anywhere in Isomursu. Rather, the cited section of Isomursu (col. 8, lines 16-44) merely deals with an electronic calendar and coordinating meeting proposals. This has nothing to do with video files or searching based on title or description information. Accordingly, claims 58, 67 and 77 are allowable over the proposed combination of Isomursu and Galensky for at least this further reason.

With respect to rejection of claims 59-60, 68-69, 76, and 78-79, applicant respectfully points out that Isomursu does not disclose or suggest video at all. In fact, Isomursu is only concerned with the exchange short user-based text messages (see, e.g., Isomursu, column 2, lines 19-39; column 14, lines 24-45; and FIG. 1). Such systems merely convey simple character-based text information and don't teach transferring video information. Nowhere in Isomursu is video, video transmission, or video playback even mentioned or suggested. Moreover, proper receipt of such messages are not confirmed. Accordingly, applicant respectfully traverses the Examiner's position with respect to any contention that system of Isomursu shows or suggests features that relate to video (or is capable of being modified to do so without extensive and thus prohibitive modification). Accordingly, the system of Isomursu fails to show or suggest searching, receiving, confirming proper receipt, browsing or reviewing video files, let alone for using such video files as an indicia of an incoming communication as specified in applicant's claims. Thus applicant's pending claims, including 59-60, 68-69, 76, and 78-79 are allowable over Isomursu and Galensky for at least this reason.

Moreover, it is further contended that Isomursu teaches editing video files as specified in claims 61 and 70. Applicant respectfully disagrees. The section of Isomursu cited in support

of this rejection (column 10, lines 32-57) has nothing to do with video files or editing whatsoever, but rather merely relates to an application for creating specialized service menus. No editing or modifying feature of video ringtones is shown or suggested by Isomursu, Galensky or any other prior art of record for at least this reason. Thus, claims 61 and 70 are allowable.

In addition, the Examiner further contends that Galensky and/or Isomursu show or suggest confirms successful receipt of the video file. Applicant respectfully disagrees. Isomursu merely indicates when some text message purporting to be an audio file is received and does not confirm its proper receipt. Streaming systems, such as the one described in Galensky do not confirm proper receipt of a communication. Moreover, Isomursu does not operate in conjunction with a distribution computer to confirm proper receipt as claimed. Accordingly, claims 76 is allowable over the proposed combination of Isomursu and Galensky for at least this further reason.

Furthermore, claims 89, 96 and 102 have been rejected in view of allegedly well known prior. Although these claims are allowable based on the discussion above as depending from an allowable base claim, MPEP § 2144.03 requires that a reference be provided to establish that such features are actually well known in the claimed context.

Not Obvious to Combine

Moreover, applicant submits it is not obvious to combine the references as the Examiner proposes. As mentioned above, the purpose of Galensky is to stream multimedia content to a simple playback device for immediate playback, whereas the purpose of Isomursu is to provide a platform from which users can exchange short text-only messages. Therefore, these systems each have fundamentally different objectives and use different platforms and different means of achieving those fundamentally different objectives, and thus cannot be combined as the Examiner proposes. Furthermore, because the system of Isomursu is a text-only system, and is not concerned with video information, it is incompatible with the streaming based multimedia system of Galensky, the two thus teach away from one another. As a result, substantial modification would be required to effect the Examiner's proposed combination, further discouraging any such attempt at combination. Moreover, no teaching is provided in the references describing how to accomplish the necessary substantial modifications nor is there any recognition within the references that such a combination would even be desirable or useful. Furthermore, such a combination would change the principal operations of the systems disclosed in the references, further discouraging such an effort.

Lastly, even if such a combination were made, it would still not produce applicant's claimed invention (i.e., it would merely produce a system suffering from all the shortcomings of Isomursu and Galensky as pointed out above).

Accordingly, applicant respectfully requests that the rejections under 35 U.S.C. § 103(a) be withdrawn.

IV. Related Cases

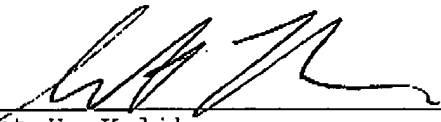
In accordance with MPEP §§ 2001 and 2002, applicant again draws the Examiner's attention to pending related cases 11/633,142 (recently allowed) and 11/633, 122 (pending rejections), and recently filed case 12/128,991 which may be considered to have similar claims to this case and thus are relevant to the examination of this case.

V. Conclusion

For at least the above reasons, claims 57-102 are patentable over the references of record. Accordingly, applicant respectfully requests that the Examiner withdraw the rejections and allow the pending claims. To expedite prosecution of this application, the Examiner is invited to call the applicant's undersigned representative to discuss any issues relating to this case.

Respectfully submitted,

Dated: 6/18/09



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